

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kevin J. Knight Art Unit: 2454
Serial No.: 10/054,164 Examiner: Coulter, Kenneth R.
Filed: January 22, 2002 Conf. No. 6168
For: **METHOD AND APPARATUS FOR SELECTING, MODIFYING AND SUPERIMPOSING ONE IMAGE ON ANOTHER**

VIA ELECTRONIC FILING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.131

SIR:

I, Mark Montague, declare as follows:

1. I am an attorney of the Law Firm of Cowan, Liebowitz & Latman ("firm"), am registered to practice before the U.S. Patent & Trademark Office (registration no. 36,612) and currently represent Alcone Marketing Group, the assignee of the present application. I am not identified on the combined declaration/power of attorney ("power of attorney"), signed by the applicant hereof, since I joined the firm after the execution date of the power of attorney. The four (4) attorneys identified on the power of attorney appointed by the applicant are no longer employees of the firm. Mr. R. Lewis Gable had represented Alcone Marketing Group, but recently retired from the practice of law.

2. I submit this Declaration for the sole purpose of providing documentation from the firm files pertaining to the application and the invention claimed in the application in order to establish that the claimed invention was actually reduced to practice prior to October 12, 1999, which is the filing date of the Berger et al. patent, U.S. patent no. 6,414,693 ("Berger"), cited in an office

action dated June 23, 2009 in the present application. In the event there is insufficient evidence to establish actual reduction to practice of the claimed invention prior to October 12, 1999, the attached documentation establishes that the claimed invention was conceived of prior to October 12, 1999 and with due diligence was developed until the filing on January 6, 2000 of the applicant's parent application, U.S. application no. 09/479,284.

3. Attached in Appendix A is a redacted copy of a document included in the firm files relating to parent application 09/479,284 (now U.S. Patent 6,344,853) that sets forth a chronology of events that relates to the invention as disclosed in the parent application (and also to the present application since the present application is a continuation of the parent application). All dates that precede "10/08/09" have been redacted for confidentiality purposes, but it is submitted that all of the redacted dates are earlier than October 8, 1999. As indicated on the bottom of the 2nd page of this document ("chronology document"), there are 7 entries with dates that occur after October 12, 1999, which is the filing date of the Berger reference. All of the other entries have dates that precede October 12, 1999 (with nearly all of those dates redacted). Based on a review of the various entries with dates that precede October 12, 1999, the document illustrates that software that carries out the functions of the invention as set forth in the application was developed or in the process of being developed prior to October 12, 1999, or, at the absolute minimum, conceived of prior to October 12, 1999.

4. Attached in Appendix B is a copy of a first invoice from the firm, dated November 23, 1999. This invoice indicates that Mr. R. Lewis Gable performed patent-related services for the Assignee of the application on October 26, 1999, and October 28, 1999.

5. Attached in Appendix C is a copy of a second invoice from the firm, dated January 25, 2000. This second invoice indicates that Mr. R. Lewis Gable performed patent-related services for the

Assignee of the application throughout November and December, 1999, and filed the parent application with the U.S. Patent & Trademark Office on January 6, 2000.

6. Based on a review of the firm files, since Mr. Gable did not file another patent application for the Assignee on this date and no other patent applications were worked on for this Assignee during this period of time, and also based on the particular account no. 23567-002 (originally 23567-000), the services performed by Mr. Gable as indicated in both invoices included in Appendices B and C clearly were for the parent application.

7. Based on the documentation included in Appendices B and C, as discussed above, representative of the efforts being performed by patent counsel during the time period of October 26, 1999 through January 6, 2000, it is believed that such documentation establishes that there was, at the minimum, due diligence in connection with the subject matter set forth in the parent application, as well as the present application, during such time period. The documentation included in Appendices B and C taken in combination with the documentation included in Appendix A, along with the filing of the parent application on January 6, 2000, establishes, in the undersigned attorney's opinion, that the application claimed in the present application was invented prior to the October 12, 1999 filing date of the cited Berger patent.

8. I hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement and the like so made are punishable by fine or imprisonment or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: Dec. 18, 2009

New York, New York, USA

By:


Mark Montague

APPENDIX A
OF
DECLARATION UNDER 37 C.F.R. § 1.131

[REDACTED] - Press Release - Macromedia Introduces Flash 3, Unveils new Server-Based Flash Generator.

[REDACTED] - Press Release - Macromedia Flash Generator(TM) Public Beta for Power Macintosh Now Available

[REDACTED] - Press Release - Macromedia Ships Generator(TM)

[REDACTED] - Drawing - Generator Test: tattoo example analysis, mug example image

[REDACTED] - Document - Creative Brief to develop InstaSample feature on PromoCity
[REDACTED] - Drawing - InstaSample screen designs: product display, control panel, InstaSample preview
[REDACTED] - Source Code - Tattoo example: technical analysis, server testing
[REDACTED] - Document - PromoCity v3.0 design with changes indicated (cooler is test product)
[REDACTED] - Drawing - PromoCity v3.0 navigation map: InstaSample location, logo libraries, site architecture

[REDACTED] - Source Code - Control panel: ctrl_x_c.htm - logos beginning with the letter "x"

[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Drawing - InstaSample directory architecture: navbar, temps, cooler (test product), images
[REDACTED] - Document - Notes recapping meeting with Matt Alcone
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - Memo from Diane Gallant; PromoCity v3.0 design with changes indicated
[REDACTED] - Document - Memo to Diane Gallant with answers to questions from item #10
[REDACTED] - Document - Memo from Diane Gallant to Linda Henry to review site
[REDACTED] - Document - PromoCity v3.0 design with changes indicated

[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - Status meeting agenda from Linda Henry
[REDACTED] - Document - Hand notes of verbal changes from Linda Henry
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - PromoCity v3.0 design with changes indicated

[REDACTED] - Drawing - PromoCity v3.0 interface design: site navigation menus, tabbed sections, attached notes from Matt Alcone with directions, changes
[REDACTED] - Source Code - Control panels: 6 - logos beginning with the letter "a,b,e,f,h,n"
[REDACTED] - Drawing - PromoCity v3.0 navigation bar design: incorporates InstaSample into site
[REDACTED] - Drawing - PromoCity v3.0 screen layout: global table specifications, frameset architecture
[REDACTED] - Document - Memo from K. Knight with InstaSample project status
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - Memo from Linda Henry to John Strait with Matt Alcone's approval to purchase Generator
[REDACTED] - Document - Memo from Linda Henry to John Strait to forward approval memo to CFO
[REDACTED] - Document - Memo from Linda Henry to Steve Wallace regarding purchase of add'l. server hardware

[REDACTED] - Document - Memo from Linda Henry to Development Team with server delivery status, proposed test date of 9/1/99, launch date of 9/14/99
[REDACTED] - Drawing - PromoCity v3.0 screen layout: InstaSample table specifications, frameset architecture
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Source Code - Control panel, Preview screen: variables naming convention
[REDACTED] - Source Code - Control panel: ctrl_a.htm - logos beginning with the letter "a"
[REDACTED] - Document - Memo from Linda Henry to Kevin Knight, Kathy Wheaton re: PromoCity press release
[REDACTED] - Drawing - InstaSample directory architecture: process, logos, product directories, file naming convention
[REDACTED] - Document - Fax of PromoCity press release to Matt Alcone
[REDACTED] - Document - InstaSample status meeting agenda
[REDACTED] - Source Code - Directory architecture: product templates, control panels, logo libraries, process/preview
[REDACTED] - Document - Memo from Linda Henry to Kevin Knight re: changes to PromoCity v3.0
[REDACTED] - Source Code - Source code/site architecture: web server - index.asp, navbar.htm; application server - preview.asp, ctrl_a.asp, colors.asp (available product colors), nav_a.asp, logos_a.asp, colors.asp (logo color palette)
[REDACTED] - Document - Memo from Linda Henry to Kevin Knight re: changes to PromoCity v3.0

[REDACTED] - Drawing - PromoCity v3.0 technical infrastructure schematic: url, firewall, traffic/load balancing system, web servers and application server (hosts Generator software).
[REDACTED] - Document - Memo from Kevin Knight to Efren Duarte re: load file onto Web and Generator servers with IP addresses for testing
[REDACTED] - Document - Memo from Kevin Knight to John Strait re: clarification of instructions to Efren Duarte
[REDACTED] - Document - Memo from Kevin Knight to John Strait re: major site changes, open firewall to Internet
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Document - Hand notes of verbal changes from Linda Henry
[REDACTED] - Document - Hand notes of verbal changes from Shelly Alberry
[REDACTED] - Document - Memo from Linda Henry with suggestions from Diane Gallant
[REDACTED] - Document - PromoCity v3.0 design with changes indicated
[REDACTED] - Source Code - Data file scan: correct logos with faulty "option value" variables
[REDACTED] - Document - Memo from Matt Alcone with input from Darien senior executives
[REDACTED] - PROMOCITY V3.0 WITH INSTASAMPLE LAUNCHES (no document)
[REDACTED] - Document - Job Order from Jill Taylor to correct logo database errors
[REDACTED] - Document - Status report from Linda Henry, approval to purchase CORPart logo CDs

10/08/99 - Document - PromoCity v3.0 design with changes indicated
10/11/99 - Document - Hand written notes with comparison to Ford Motor Company site
10/13/99 - Document - Printout of product categories with notes by Matt Alcone
10/21/99 - Source Code - Source code: application server - preview.asp, colors.asp (available product colors), colors.asp (logo color palette)
10/29/99 - Document - PromoCity v3.0 design with changes indicated

11/02/99 - Document - Memo from Linda Henry to Matt Alcone re: daily changes scheduling, memo from Matt Alcone
11/03/99 - Document - Memo from Jill Taylor re: changes, memo from Matt Alcone
11/05/99 - Document - List of InstaSample products for site launch, index page layout sketch
11/05/99 - Document - PromoCity v3.0 design with changes indicated

APPENDIX B
OF
DECLARATION UNDER 37 C.F.R. § 1.131

Alcone Marketing Group
4 Studebaker
Irvine CA 92618-2012

Page: 1
November 23, 1999
Account No: 23567-00M
Statement No: 95146

Attn: Ms. Karen Anderson

		Hours	
10/26/99	RLG Teleconference with Linda Henry re patent rights in internet software and forward by October 27 letter a copy of State Street patent to L. Henry.	0.50	155.00
10/28/99	RLG Teleconference with L. Henry re initial steps to gather a description of the invention for preparation of patent specification and discuss need for Employment Agreement.	0.50	155.00
10/29/99	RLG Review Employment agreement.	0.30	93.00
	For Current Services	1.30	403.00
	Recapitulation		
Timekeeper		Hours	
R. Lewis Gable		1.30	\$310.00
			Total
			\$403.00
Federal Express			12.55
Total Expenses Through 11/23/99			12.55
TOTAL CURRENT WORK			415.55
BALANCE DUE			\$415.55
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APPENDIX C
OF
DECLARATION UNDER 37 C.F.R. § 1.131

Alcone Marketing Group
4 Studebaker
Irvine CA 92618-2012

Page: 1
January 25, 2000
Account No: 23567-02M
Statement No: 100244

Attn: Ms. Karen Anderson

"Insta Sample" - Website Software for Imposing
Images on Promotional Merchandise

		Hours
11/04/99	RLG Initial review of flow diagram from K. Knight.	0.50 155.00
11/05/99	RLG Review disclosure materials; Extended teleconference with K. Knight re nature and functionality of this invention; and Prepare request to search service to conduct Novelty and Infringement search.	2.50 775.00
11/08/99	RLG Provide instructions by November 8 letter to search service to initiate a novelty and infringement search.	1.20 372.00
11/09/99	RLG Review L. Henry's November 8 E-Mail and review E-sample website; Teleconference with S. Schutte re potential scope of claimed invention.	0.50 155.00
11/10/99	RLG Exchange of E-Mails and teleconference with L. Henry as to existing novel features that would support a patent application and what further enhancements (features) to include within written specification.	0.50 155.00
11/16/99	RLG Initial review of search results.	0.50 155.00
11/17/99	RLG Review results of NERAC search.	0.60 186.00
11/18/99		

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RLG	Study results of NERAC search.		0.40	124.00
11/30/99	RLG Teleconference with our computer search service re search strategy; Redirect search and review results of further search.		1.40	434.00
12/01/99	RLG Follow-up with search service to review search argument and to extend search to cover the Internet.		0.60	186.00

			Hours
12/03/99	RLG	Prepare and forward novelty and infringement investigation search report letter of December 3 to L. Henry.	2.00
12/08/99	RLG	Prepare first draft of patent application.	2.50
12/09/99	RLG	Teleconference with K. Knight regarding related screens and preparation of first draft of patent application.	0.70
	RLG	Prepare specification; Provide by E-Mail status report to L. Henry	1.80
12/13/99	RLG	Continue to prepare first draft of patent application.	1.10
12/14/99	RLG	Continue to prepare first draft of patent application.	2.00
12/15/99	RLG	Continue to prepare first draft of patent application; Review screens from R. Criscer.	1.60
12/16/99	RLG	Continued preparation of first draft of patent application.	1.50
12/17/99	RLG	Continue to prepare first draft of patent application; Teleconference with L. Henry	465.00

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	re status of application and employment agreement; Teleconference with K. Knight.		2.20	682.00
12/18/99	RLG Continued preparation of first draft of specification and claims.		2.00	620.00
12/19/99	RLG Continued preparation of first draft of specification and claims.		2.80	868.00
12/20/99	RLG Revise and send revised application and drawings to Kevin Knight for his review.		1.90	589.00
12/21/99	RLG Review and revise application; Teleconference with K. Knight re application and fine tuning description			

0 Alcone Marketing Group Page: 3
 January 25, 2000
 Account No: 23567-02M
 Statement No: 100244
 "Insta Sample" - Website Software for Imposing
 Images on Promotional Merchandise

	of operation.	Hours	
		1.30	403.00
12/22/99	RLG Teleconference with L. Henry re status of application; Extended teleconference with K. Knight re nature and operation of invention.	1.20	372.00
12/23/99	RLG Prepare second draft of application which was revised in accordance with discussion with and written revisions in first draft by K. Knight.	2.00	620.00
12/24/99	RLG Edit and revise third draft of patent applications per K. Knights comments.	2.80	868.00
12/27/99	RLG Further revision of specification in view of comments of K. Knight.	2.00	620.00
12/29/99	RLG Final editing and revising of specifications before sending to K. Knight for review.	1.70	527.00
12/30/99	RLG Review and forward revised application and drawing to K. Knight for review.	1.00	310.00

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01/05/00

RLG Teleconference with K. Knight re changes to application; Teleconference with L. Henry re status of application and need for assignment, declaration and employment agreement. 1.50 480.00

01/06/00

RLG Attend to preparing declaration and assignment and e-mailing same to L. Henry for review; Revise application; Teleconferences with L. Henry and K. Knight re assignment and declaration and further changes to specification; Redraft to include further features per discussions with L. Henry and K. Knight; Forward to K. Knight revised application for review and assignment and declaration for execution by inventor; Attend to filing patent application and related papers in U.S. Patent & Trademark Office; Confirm such filing by January 6 letter to L. Henry. 1.40 448.00

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Alcone Marketing Group

Page: 4

January 25, 2000

Account No: 23567-02M

Statement No: 100244

"Insta Sample" - Website Software for Imposing Images on Promotional Merchandise

For Current Services 45.70 14,196.00

Recapitulation

Timekeeper	Hours	Rate	Total
R. Lewis Gable	42.80	\$310.00	\$13,268.00
R. Lewis Gable	2.90	320.00	928.00

Fee to Commissioner of Patents & Trademarks for filing fee	784.00
Photocopy charges	0.60
Facsimile charges	19.50
Long distance telephone charges	28.50
Total Expenses Through 01/25/00	832.60
TOTAL CURRENT WORK	15,028.60

BALANCE DUE	\$15,028.60
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